

DOCKET NO: 289264US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
STEFAN KIRSCH, ET AL. : EXAMINER: REDDY, K. P.
SERIAL NO: 10/579,096 :
FILED: MAY 12, 2006 : GROUP ART UNIT: 1796
FOR: POLYMER-CONTAINING :
SULFOSUCCINATE DISPERSIONS :

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated January 21, 2009 (Answer).

The statement of the Grounds of the Rejection (Answer at 3-8) is identical to the statement in the Office Action dated July 30, 2008, which has already been responded to in the Appeal Brief. In addition, part of the Response to Argument (Answer at 10) has already been responded to in the Appeal Brief. The following is in reply to the new arguments raised by the Examiner in the Response to Argument (Answer at 10-12).

Noting that the claims recite enhancing at least one performance property, the Examiner finds that Wood et al discloses improved water whitening resistance with removal of ionic compounds and that BASF discloses improved wetting behavior by adding a sodium salt of dioctyl sulfosuccinate; the Examiner then finds that both Wood et al and BASF "teach individually an improvement in at least one performance property and meets the claim limitation" (Answer at 10).

In reply, the Examiner's finding ignores the fact that the sodium salt of dioctyl sulfosuccinate of BASF is a species of water-soluble ionic compound that Wood et al teaches should be removed. Thus, this finding is incongruous.

Regarding Applicants' argument about unexpected results, the Examiner finds that Applicants have disclosed in the specification that the water-soluble ionic compound can be present in amounts up to 5 parts by weight per 100 parts by weight of dispersed polymer prior to removal in the removing step, and then finds that “[a]bsent evidence of how much water-soluble ionic compound was present initially and removed in first step in the example, it is not clear how the transparency of Acronal A220 (an aqueous polymer dispersion) processed according to present method, can be compared to the transparency or lack of transparency of Acronal A220 wherein the amount of water-soluble ionic compound is unknown. Thus, examiner disagrees with appellant's argument of a showing of unexpected results. In addition, the scope of present independent claim 1 is open to addition to any amount of a salt of monoalkyl or dialkyl ester of sulfonated succinic acid” (Answer at 11).

In reply, and as Applicants pointed out in the Appeal Brief, the unexpected result is that adding the salt of a monoalkyl or dialkyl ester of a sulfonated dicarboxylic acid (sulfonated dicarboxylic acid ester salt) after at least 50 mol% of water-soluble ionic compounds already present have been removed, does not result in water whitening. This unexpected result does not depend on how much water-soluble ionic compound was present initially, so long as at least 50 mol% is removed, nor does the unexpected result depend on how much sulfonated dicarboxylic acid ester salt is added. Nevertheless, while the unexpected results described in the specification herein are indicia of patentability, they are not absolutely necessary, because the Examiner has not made out a *prima facie* case of obviousness. Indeed, Wood et al teaches away from adding back **any** amount of water-

soluble ionic compound once the existing water-soluble ionic compounds therein have been removed.

With regard to the data in Table 1 of the specification for 60 minutes, the Examiner continues to find that the aqueous dispersion prepared according to the present invention “show some decrease in water-whitening resistance and is an expected result” (Answer at 12).

In reply, the evidence in Table 1 does not support the Examiner’s finding.

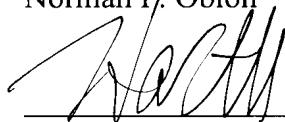
The Examiner finds that there is no data in the specification to support Applicants’ argument “that there was a significant difference in wetting behavior after 1% of a salt of dialkyl ester of sulfonated succinic acid [was added?]” (Answer at 12).

In reply, while there is no numerical data in Table 1 with regard to difference in wetting behavior, Applicants describe in the specification that the samples subjected to diafiltration without Lumiten showed “poor” wetting behavior, but that following addition of Lumiten, the wetting of the samples on the surface to be coated was “good,” as described in the specification at page 11, lines 18-20. Clearly, it cannot be disputed that the difference between “poor” and “good” is significant.

Applicants continue to maintain that the rejections should be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Harris A. Pitlick
Registration No. 38,779

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)